

REMARKS

Summary of the Office Action and this Amendment

In the office action mailed 9/22/2005, claims 1-91 (all of the claims pending at the time of the office action), were rejected. The claims were rejected under 35 U.S.C. 102(b) and 35 U.S.C. 103(a).

The examiner rejected claims under 35 U.S.C. 102(b) as follows: On page two of the office action, the examiner stated that “[c]laims 1, 2, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,682,469 to Linnett et al” On page 4 of the office action, the examiner stated that “[c]laims 1, 3, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,766,541 to Bleich et al” On page 6 of the office action the examiner stated that “[c]laims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent No. 10-201954 A to Kanbe et al”

The examiner rejected claims under 35 U.S.C. 103(a) as follows:

On page 8, claims 4, 7, 11, 14, 24, and 25 were rejected as being unpatentable over Linnett et al in view of U.S. Patent 6,600,491 to Szeliski et al.

On page 11, claims 11, 12, 15, 16, 18, 19, 20, 22, 23, 26, 28, 30-34, 80, 87, 89, and 90 were rejected as being unpatentable over Kanabe et al in view of Szeliski et al.

On page 23, claims 13, 17, 21, 81, 82, and 91 were rejected as being unpatentable over Kanabe et al in view of Szeliski et al and in further view of U.S. Patent No. 6,798,426 to Tateishi.

On page 27, claims 27, 29, 35, 83, 86, and 88 were rejected as being unpatentable over Kanabe et al in view of Szeliski et al and in further view of U.S. Patent No. 6,676,518 to Sawa et al.

On page 30, claims 8, 10, 36, 37, 42, 47, 51-56, 64, 65, 66, 68, 70, 73-79, 84, and 85 were rejected as being unpatentable over Kanabe et al in view of Sawa et al.

On page 42, claim 38 was rejected as being unpatentable over Kanabe et al in view of Sawa et al and in further view of U.S. Patent 6,784,901 to Harvey et al.

On page 42, claims 39 and 40 were rejected as being unpatentable over Kanabe et al in view of Sawa et al and Harvey et al and in further view of Szeliski et al.

On page 44, claim 41 was rejected as being unpatentable over Kanabe et al in view of Sawa et al, Harvey et al, Szeliski et al in further view of Linnett et al.

On page 45, claim 43-46, 57, 59, 69, 71, and 72 were rejected as being unpatentable over Kanabe et al in view of Sawa et al and in further view of Szeliski et al.

On page 50, claims 48, 49, 50, 58, and 67 were rejected as being unpatentable over Kanabe et al in view of Sawa et al and in further view of Tateishi.

On page 52, claims 60-63 were rejected as being unpatentable over Kanabe et al in view of Sawa et al and in further view of Linnett et al.

In this Amendment, applicant has amended claims 1-30, 34-71, 73-81, 83-84, 86-89, and 91. Support for the amendments can be found, for example, in Figure 1, and at pages 3-4, and 7-9 of the specification. No new matter has been added. Claims 1-91 are now pending in the application.

Claim Rejections - 35 U.S.C. 102 and 103

a. Legal Criteria 35 U.S.C. 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). . . . "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

MPEP § 2131 (8th ed., rev. 3, Aug. 2005).

b. Legal Criteria 35 U.S.C. 103

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

MPEP § 706.02(j) (8th ed., rev. 3, Aug. 2005).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also

suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

MPEP § 2143.01 (8th ed., rev. 3, Aug. 2005) (emphasis in original).

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

MPEP § 2141 (8th ed., rev. 3, Aug. 2005).

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

MPEP § 2141.02 (8th ed., rev. 3, Aug. 2005).

c. Discussion

In this amendment, applicant has amended all of the independent claims, which are claims 1, 11, 30, 36, 42, 80, 84, 87, and 89. Applicant submits that all the independent claims presented herein include limitations that are not described in any of the cited references, and are not taught or suggested by any of the cited references.

For example, claims 1, 11, 36, 42, 80, 84, 87, and 89 as amended herein include at least the following limitations that are not disclosed in the references, and that are not taught or suggested by the references:

presenting on a display a series of concatenated pictures of the real world to provide a real world background scene having life-like movement;

presenting on the display a series of video clips of a real person, wherein the series of video clips present the appearance of a continuous and moving image of the real person on the display; wherein the series of video clips of the real person are presented on the display contiguous with the real world background scene and completely within outside edges of the real world background scene on the display;

presenting on the display a three-dimensional representation of a playing area, wherein the three-dimensional representation of the playing area is presented on the display contiguous with the real world background scene and completely within the outside edges of the real world background scene on the display;

presenting on the display a two-dimensional representation of the playing area, wherein the two-dimensional representation of the playing area is presented on the display contiguous with the real world background scene and completely within the outside edges of the real world background scene on the display, and wherein the two-dimensional representation of the playing area is

partially transparent to permit viewing a portion of the real world background scene through the two-dimensional representation of the playing area;

wherein the series of video clips of the real person, and the three-dimensional representation of the playing area, and the two-dimensional representation of the playing area are presented in separate nonoverlapping areas within the outside edges of the real world background scene;

wherein the real world background scene and the series of video clips of the real person and the three-dimensional representation of the playing area and the two-dimensional representation of the playing area are visible substantially simultaneously on the display.

For example, claim 30 as amended herein includes at least the following limitations that are not disclosed in the references, and that are not taught or suggested by the references:

presenting on a display a series of concatenated pictures of the real world to provide a real world background scene having life-like movement;

presenting on the display a series of animation clips of a character, wherein the series of animation clips present the appearance of a continuous and moving animated character on the display; wherein the series of animation clips of the character are presented on the display contiguous with the real world background scene and completely within outside edges of the real world background scene on the display;

presenting on the display a three-dimensional representation of a playing area, wherein the three-dimensional representation of the playing area is presented on the display

contiguous with the real world background scene and completely within the outside edges of the real world background scene on the display;

presenting on the display a two-dimensional representation of the playing area, wherein the two-dimensional representation of the playing area is presented on the display contiguous with the real world background scene and completely within the outside edges of the real world background scene on the display, and wherein the two-dimensional representation of the playing area is partially transparent to permit viewing a portion of the real world background scene through the two-dimensional representation of the playing area;

wherein the series of animation clips of the character, and the three-dimensional representation of the playing area, and the two-dimensional representation of the playing area are presented in separate nonoverlapping areas within the outside edges of the real world background scene;

wherein the real world background scene and the series of animation clips of the character and the three-dimensional representation of the playing area and the two-dimensional representation of the playing area are visible substantially simultaneously on the display.

Further, each of the independent claims includes additional limitations that are not disclosed in the references, and that are not taught or suggested by the references. Accordingly, applicant submits that the independent claims as presented herein are not anticipated by any of the references, because each and every element as set forth in the claims is not found, either expressly or inherently described in any of the references. Further, applicant submits that the independent claims as presented herein are not obvious, because the references when combined

do not teach or suggest all of the claim limitations, and further, there is no suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings.

Amendments, and Dependent Claims in General

In this amendment applicant has also amended many of the dependent claims. Applicant submits that the dependent claims are novel and nonobvious for at least the reasons discussed above with regard to the independent claims.

Some of the claim amendments in this amendment were made to clarify the wording and to correct typographical errors.

Conclusion

In summary, applicant respectfully submits that the claims as presented herein are novel and nonobvious. In conclusion, applicant respectfully submits that the application is in condition for allowance, and applicant requests reconsideration and further examination, and allowance of the application.

Respectfully submitted,

Tim Ellis

Timothy N. Ellis
Reg. No. 41,734
Attorney for Applicant
telephone (858)455-7977